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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,196	01/11/2000	PAUL MATTHEW PIRILLO	8461	5306

7590 11/08/2002

PAUL W MARTIN  
NCR CORPORATION  
LAW DEPARTMENT  
101 W SCHANTZ AVENUE  
DAYTON, OH 45479

EXAMINER

CHANG, SABRINA A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/481,196

Applicant(s)

PIRILLO, PAUL MATTHEW

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because the margins for Figures 1-10 are too small. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. U.S. Patent No. 6,327,573.

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Walker et al. discloses a system and method of enabling frequent shoppers to receive and use rewards for frequent purchases. The system keeps track of a shopper's demographic profile [Col 6, Line 45], purchase history [Col 6, Line 26] as well as their reward use history – points earned and/or redeemed [Col 6, Line 29]. This information may be stored in a central database [Col 4, Line 64. Fig. 1, Element 400A] or on a client device – e.g. a smart card, magnetic-stripe card or a Personal Digital Assistant PDA, or PDA [Col 5, Line 4]. The shopper uses the client device to access a point of sale terminal within a transactional environment. The customer's usage history is used to generate a customized display and allows the shopper to place an order directly from the terminal [Col 16, Lin 28].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. U.S. Patent No. 6,327,573 in view of the article "All About eBooks" (January 5, 2000. African American Literature Book Club. [www.aalbc.com/writers/ebooks/Allaboutebooks.htm](http://www.aalbc.com/writers/ebooks/Allaboutebooks.htm)).

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Walker et al. discloses a system and method of enabling frequent shoppers to receive and use rewards for frequent purchases. The system keeps track of a shopper's demographic profile [Col 6, Line 45], purchase history [Col 6, Line 26] as well as their reward use history – points earned and/or redeemed [Col 6, Line 29]. This information may be stored in a central database [Col 4, Line 64. Fig. 1, Element 400A] or on a client device – e.g. a smart card, magnetic-stripe card or a Personal Digital Assistant PDA, or PDA [Col 5, Line 4]. The shopper uses the client device to access a point of sale terminal within a transactional environment. The terminal has a computer or video display, a printer, a keyboard and/or a touch screen display [Col 3, Line 57]. The customer's usage history is used to generate a customized display and allows shopper the shopper to place an order directly from the terminal [Col 16, Lin 28].

Walker et al. does not explicitly disclose that:

- The data transfer interface includes a download cradle specifically adapted to connect with an electronic book reader.
- The download cradle is specifically adapted to read customer information from the electronic book reader
- That the terminal is operative to cryptoprocess data for delivery to the electronic book reader
- That the data transfer interface includes a compact disk

“eBooks” teaches an in-store kiosk that allows a user to securely download electronic book media (cryptoprocess) onto his/her client eBook device [Description of Glassbook Bookstore Kiosk]. Furthermore, the article teaches the possibility of combining eBook hardware technology with basic PDA technology

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in order to minimize the nuisance to the consumer in carrying multiple devices [Final Note].

It would have been obvious to modify the PDA-based customer management system of Walker et al. to include the ability to download eBook media to the device, as taught by "eBooks", in order to reduce the number of devices a consumer needs to carry.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. U.S. Patent No. 6,327,573 in view of the article "All About eBooks" (January 5, 2000. African American Literature Book Club. [www.aalbc.com/writers/ebooks/Allaboutebooks.htm](http://www.aalbc.com/writers/ebooks/Allaboutebooks.htm)), as rejected in Claims 2-6, in further view of "Tesco to use 'class' system for customer discounts". (Cope, Nigel. April 7, 1999. The Independent).

The invention of Walker et al. and "eBooks" does not provide for making purchasing recommendations to the consumer based upon their purchase history.

"Tesco" teaches an in-store marketing system. Shoppers are identified at in-store kiosks by their identity cards and are given customized information based upon their purchasing histories including targeted special promotions [recommendations].

It would have been obvious to modify the system of Walker et al./"eBooks" to provide recommendations for customer purchases, as taught by "Tesco", in order to give the customer with more relevant, personalized information and increase the likelihood of purchase.

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Claims 10 –14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being over Walker et al. U.S. Patent No. 6,327,573 in view of “Tesco to use ‘class’ system for customer discounts.” (Cope, Nigel. April 7, 1999. The Independent).

Walker et al. discloses a system and method of enabling frequent shoppers to receive and use rewards for frequent purchases. The system keeps track of a shopper’s demographic profile [Col 6, Line 45], purchase history [Col 6, Line 26] as well as their reward use history – points earned and/or redeemed [Col 6, Line 29]. This information may be stored in a central database [Col 4, Line 64. Fig. 1, Element 400A] or on a client device – e.g. a smart card, magnetic-stripe card or a Personal Digital Assistant PDA, or PDA [Col 5, Line 4]. The shopper uses the client device to access a point of sale terminal within a transactional environment. The terminal has a computer or video display, a printer, a keyboard and/or a touch screen display [Col 3, Line 57]. The usage history is used to generate a customized display and the shopper can place an order directly from the terminal [Col 16, Lin 28]. The terminal may also be used to play video, games, music or other entertainment programs [Col 16, Line 34] (provide remote audio and video communication).

Walker et al. does not disclose providing the consumer with advertising based upon their purchase history.

“Tesco” teaches an in-store marketing system. Shoppers are identified at in-store kiosks by their identity cards and are given customized information based upon their purchasing histories including targeted special promotions [advertising from an advertising server].

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It would have been obvious to modify the system of Walker et al to provide customized advertising, as taught by "Tesco", in order to give the customer with more relevant, personalized information and increase the likelihood of purchase.

Claim 15 is rejected under 35 U.S.C. 103(a) as being over Walker et al. U.S. Patent No. 6,327,573 in view of "Tesco to use 'class' system for customer discounts." (Cope, Nigel. April 7, 1999. The Independent), as rejected in claims 10-14, in further view of the article "All About eBooks" (January 5, 2000. African American Literature Book Club.

[www.aalbc.com/writers/ebooks/Allaboutebooks.htm](http://www.aalbc.com/writers/ebooks/Allaboutebooks.htm)).

The system of Walker et al./ "Tesco" does not provide for a terminal that is operative to cryptoprocess media for delivery to contact devices.

"eBooks" teaches an in-store kiosk that allows a user to securely download electronic book media with guaranteed copyright protection (cryptoprocess) onto his/her client eBook device [Description of Glassbook Bookstore Kiosk]. Furthermore, the article teaches the possibility of combining eBook hardware technology with basic PDA technology in order to minimize the nuisance to the consumer in carrying multiple devices [Final Note].

It would have been obvious to modify the PDA-based customer management system of Walker et al. to include the ability to download eBook media to the device securely, as taught by "eBooks", in order to increase efficiency for the consumer, in reducing the number of devices they need to carry, while also protecting the rights of authors and publishers.



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Claim 21 is rejected under 35 U.S.C. 103(a) as being over Walker et al. U.S. Patent No. 6,327,573, as rejected in claims 18-20, in view of "Allair Jrn Chosen to Power In-Store Information Kiosks for Home Depot" (November 8, 1999. PR Newswire).

Walker et al. does not explicitly disclose that the customer can retrieve advertising content wherein the advertising content are processed at the terminal to generate a java applet.

"Allaire" teaches an in-store kiosk system that uses Java servelets in order to deliver more timely and accurate information to shoppers.

It would have been obvious to modify the system of Walker et al. to provide promotions using Java technology to make information delivery and updating more efficient.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Handelman et al. U.S. Patent No. 6,298,441 discloses a method for downloading documents and/or electronic media using a smart card. Handelman et al. does not explicitly disclose any customer management functionality, i.e. tracking customer history or usage patterns.

Mankoff U.S. Patent No. 6,385,591 discloses a coupon retrieval system. The consumer receives an electronic coupon and stores it on their PDA for

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redemption at an in-store terminal. Mankoff does not explicitly disclose the download of electronic media to the PDA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 7687 for regular communications and 703 305 7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC  
November 1, 2002

  
J. FREYA SMITH  
PRIMARY EXAMINER